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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|-------------------------------------|------------------|
| 10/014,112 | 12/11/2001 | Harold Aaron Ludtke | SONY 3.0-020 ² | 3954 |
| 530 7590 04/07/2006 LERNER, DAVID, LITTENBERG, KRUMHOLZ & MENTLIK 600 SOUTH AVENUE WEST WESTFIELD, NJ 07090 | | | EXAMINER CANGIALOSI, SALVATORE A | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3621 | |

DATE MAILED: 04/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|---|--------------------------------------|--|
| Office Action Summary | Application No. 10/014,112 | Applicant(s) LUDTKE ET AL. | |
| | Examiner Salvatore Cangialosi | Art Unit 3621 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,5-10,12,14,15-52,67-104, 106-114, 116-123 is/are pending in the application.
- 4a) Of the above claim(s) 15-52,67-104 and 106-108 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,5-10,12,14,109-114 and 116-123 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>2/9/06</u> . | 6) <input type="checkbox"/> Other: _____ |

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1. Claims 15-52, 67-104, 106-108 stand withdrawn from further consideration for reasons of record in paragraph 1 of the Office action dated 12/22/2004 and should be deleted. Applicants arguments dated 08/22/2005 are unpersuasive.

2. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

3. Claims 1, 2, 5-10, 12, 14, 109-114, 116-123 are rejected under 35 U.S.C. § 103 as being unpatentable over Pare, Jr et al (5838812) in view of Dulude et al (6310966) and Kawan (5796832) and either Johnson (5598474), Gerety et al (6560741) or Shinn (6655585).

Regarding claim 1, Pare, Jr et al (See abstract, Figs. 8-11, 24, 25, Col. 11, lines 5-57, Col. 14, lines 32-64, Col. 15, lines 20-35, Col. 18, lines 5-55, claims 1, 4) disclose

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method for employing transaction employing a biometric input including intermediaries and transmission of verification substantially as claimed. The differences between the above and the claimed invention is the use of specific automatic transmission of a biometric input and point of comparison. It is noted that it is believed that the biometric parameter(See Col. 8, lines 50-55) are functionally equivalent to the claimed limitations and that the claim as drawn is readable on any the well established biometric based transaction methods. Dulude et al (See Fig. 4, Col. 5, lines 50-65, Col. 6, lines 1-25) show biometric inputs and unique user data at a transaction point transmitted over a network. Kawan (See abstract, Figs. 1-4, 6, Col. 3, lines 1-30, Col. 4, lines 1-15, Col. 8, lines 50-55, claims 1, 5,19) show a method for wirelessly effecting a transaction employing a biometric input. Each of Johnson(element 20), Gerety et al (Fig. 12) or Shinn(Fig. 5) show the local comparison of biometric data prior to a transaction. It would have been obvious to the person having ordinary skill in this art to provide a similar arrangement for Pare, Jr et al because the biometric inputs are conventional functional equivalents with respect to the claim limitations and their employment and comparison is a necessary component of validation and use in a transaction method and because local comparison would reduce fraudulent transactions and save network calls for unverified users. Regarding the device limitations of claim 2, Kawan (See

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Claim 5) show cell phone which is a functional equivalent of the claim limitations. Regarding the device limitations of claim 3, Kawan (See Claim 31) show ATM which is a functional equivalent of the claim limitations. Regarding the information limitations of claim 5, Kawan show point of sale terminal data access which is a functional equivalent of the claim limitations. Regarding the information limitations of claim 6, Kawan show point of sale terminal data access which is a functional equivalent of the claim limitations. Regarding the information limitations of claim 7, Kawan (See Col. 4, lines 55-65) show credit authorization terminal and card, which is a functional equivalent of the claim limitations. Regarding claim 8, Pare, Jr et al (See abstract, Figs. 8-11, 24,25, Col. 11, lines 5-57, Col. 14, lines 32-64, Col. 15, lines 20-35, Col. 18, lines 5-55, claims 1, 4) disclose method for employing transaction employing a biometric input including intermediaries and transmission of verification substantially as claimed. The differences between the above and the claimed invention is the use of specific automatic transmission of a biometric input and point of comparison. It is noted that it is believed that the biometric parameter (See Col. 8, lines 50-55) are functionally equivalent to the claimed limitations and that the claim as drawn is readable on any the well established biometric based transaction methods. Dulude et al (See Fig. 4, Col. 5, lines 50-65, Col. 6, lines 1-25) show biometric inputs and unique user data at a transaction point

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transmitted over a network and Dulude et al (element 66) show a database. Kawan (See abstract, Figs. 1-4, 6, Col. 3, lines 1-30, Col. 4, lines 1-15, Col. 8, lines 50-55, claims 1, 5,19) show a method for wirelessly effecting a transaction employing a biometric input. Each of Johnson(element 20), Gerety et al (Fig. 12) or Shinn(Fig. 5) shows the local comparison of biometric data prior to a transaction. It would have been obvious to the person having ordinary skill in this art to provide a similar arrangement for Pare, Jr et al because the biometric inputs are conventional functional equivalents with respect to the claim limitations and their employment and comparison is a necessary component of validation and use in a transaction method and because local comparison would reduce fraudulent transactions and save network calls for unverified users. Regarding the database limitations of claim 9, Dulude et al(element 66) show a database which is a functional equivalent of the claim limitations. Regarding the fingerprint limitations of claim 10, Kawan (See Col. 8, lines 50-55) show a fingerprint which is a functional equivalent of the claim limitations. Regarding the database comparison limitations of claim 12, Dulude et al(See abstract and element 66) show a database comparison based on biometric generation input and comparison against a stored value which is a functional equivalent of the claim limitations. Regarding the visual limitations of claim 14, Dulude et al(See claim 8) show a database comparison based on biometric generation input and

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comparison against a stored value which is a functional equivalent of the claim limitations. Regarding the limitations of claim 109, Dulude et al (See abstract and element 66) show a database comparison based on biometric generation input and comparison against a stored value and subsequent verification which is a functional equivalent of the claim limitations.

Regarding the network limitations of claim 110, Dulude et al (See Fig. 4, Col. 5, lines 50-65, Col. 6, lines 1-25) show biometric inputs at a transaction point transmitted over a network n which is a functional equivalent of the claim limitations. Regarding claim 111, Pare, Jr et al (See abstract, Figs. 8-11, 24,25, Col. 11, lines 5-57, Col. 14, lines 32-64, Col. 15, lines 20-35, Col. 18, lines 5-55, claims 1, 4) disclose means for employing transaction employing a biometric input including intermediaries and transmission of verification substantially as claimed. The differences between the above and the claimed invention is the use of specific automatic transmission of a biometric input and point of comparison. It is noted that it is believed that the biometric parameter (See Col. 8, lines 50-55) are functionally equivalent to the claimed limitations and that the claim as drawn is readable on any the well established biometric based transaction methods. Dulude et al (See Fig. 4, Col. 5, lines 50-65, Col. 6, lines 1-25) show biometric inputs and unique user data at a transaction point transmitted over a network. Kawan (See abstract, Figs. 1-4, 6, Col. 3, lines 1-30, Col. 4, lines 1-

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15, Col. 8, lines 50-55, claims 1, 5,19) show a means for wirelessly effecting a transaction employing a biometric input. Each of Johnson(element 20), Gerety et al (Fig. 12) or Shinn(Fig. 5) show the local comparison of biometric data prior to a transaction. It would have been obvious to the person having ordinary skill in this art to provide a similar arrangement for Pare, Jr et al because the biometric inputs are conventional functional equivalents with respect to the claim limitations and their employment and comparison is a necessary component of validation and use in a transaction method and because local comparison would reduce fraudulent transactions and save network calls for unverified users. Regarding the device limitations of claim 112, Kawan (See Claim 5) show cell phone which is a functional equivalent of the claim limitations. Regarding the information limitations of claim 113, Pare, Jr et al (See abstract, Figs. 8-11, 24,25, Col. 11, lines 5-57, Col. 14, lines 32-64,Col. 15, lines 20-35, Col. 18, lines 5-55, claims 1, 4) disclose means for employing transaction employing a biometric input including intermediaries and transmission of verification including user entered PIN(see Col. 6, lines 10-40) that is a functional equivalent of the claim limitations. . Regarding claim 116, Pare, Jr et al (See abstract, Figs. 8-11, 24,25, Col. 11, lines 5-57, Col. 14, lines 32-64,Col. 15, lines 20-35, Col. 18, lines 5-55, claims 1, 4) disclose means for employing transaction employing a biometric input including intermediaries

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and transmission of verification substantially as claimed. The differences between the above and the claimed invention is the use of specific automatic transmission of a biometric input and point of comparison. It is noted that it is believed that the biometric parameter(See Col. 8, lines 50-55) are functionally equivalent to the claimed limitations and that the claim as drawn is readable on any the well established biometric based transaction methods. Dulude et al(See Fig. 4, Col. 5, lines 50-65, Col. 6, lines 1-25) show biometric inputs and unique user data at a transaction point transmitted over a network and Dulude et al(element 66) show a database. Kawan (See abstract, Figs. 1-4, 6, Col. 3, lines 1-30, Col. 4, lines 1-15, Col. 8, lines 50-55, claims 1, 5,19) show a method for wirelessly effecting a transaction employing a biometric input. Each of Johnson(element 20), Gerety et al (Fig. 12) or Shinn(Fig. 5) shows the local comparison of biometric data prior to a transaction. It would have been obvious to the person having ordinary skill in this art to provide a similar arrangement for Pare, Jr et al because the biometric inputs are conventional functional equivalents with respect to the claim limitations and their employment and comparison is a necessary component of validation and use in a transaction method and because local comparison would reduce fraudulent transactions and save network calls for unverified users. Regarding the database limitations of claim 117, Dulude et al(element 66) or Pare, Jr et al (See Col. 68, lines 30-55) show

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a database which is a functional equivalent of the claim limitations. Regarding the fingerprint limitations of claim 118, Pare, Jr et al (See Col. 13, lines 10-20) show a fingerprint scanner which is a functional equivalent of the claim limitations. Regarding the verification limitations of claim 119, Pare, Jr et al (See Fig. 20C) show a verification packet which is a functional equivalent of the claim limitations. Regarding the visual limitations of claim 120, Dulude et al (See claim 8) show a database comparison based on biometric generation input and comparison against a stored value which is a functional equivalent of the claim limitations. Regarding the verification limitations of claim 121, Pare, Jr et al (See Fig. 20C) show a verification packet which is a functional equivalent of the claim limitations. Regarding the database limitations of claim 122, Dulude et al (element 66) or Pare, Jr et al (See Col. 68, lines 30-55) show a database which is a functional equivalent of the claim limitations. Regarding claim 123, Pare, Jr et al (See abstract, Figs. 8-11, 24,25, Col. 11, lines 5-57, Col. 14, lines 32-64, Col. 15, lines 20-35, Col. 18, lines 5-55, claims 1, 4) disclose means for employing transaction employing a biometric input including intermediaries and transmission of verification substantially as claimed. The differences between the above and the claimed invention is the use of specific automatic transmission of a biometric input and point of comparison. It is noted that it is believed that the biometric parameter (See Col.

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8, lines 50-55) are functionally equivalent to the claimed limitations and that the claim as drawn is readable on any the well established biometric based transaction methods. Dulude et al (See Fig. 4, Col. 5, lines 50-65, Col. 6, lines 1-25) show biometric inputs and user unique data related to a credit card number at a transaction point transmitted over a network. Kawan (See abstract, Figs. 1-4, 6, Col. 3, lines 1-30, Col. 4, lines 1-15, Col. 8, lines 50-55, claims 1, 5,19) show a means for wirelessly effecting a transaction employing a biometric input. Each of Johnson(element 20), Gerety et al (Fig. 12) or Shinn(Fig. 5) show the local comparison of biometric data prior to a transaction. It would have been obvious to the person having ordinary skill in this art to provide a similar arrangement for Pare, Jr et al because the biometric inputs are conventional functional equivalents with respect to the claim limitations and their employment and comparison is a necessary component of validation and use in a transaction method and because local comparison would reduce fraudulent transactions and save network calls for unverified users.

Examiner's Note: Although Examiner has cited particular columns, line numbers and figures in the references as applied to the claims above for the convenience of the applicant(s), the specified citations are merely representative of the teaching of the prior art that are applied to specific limitations within the

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individual claim and other passages and figures may apply as well. It is respectfully requested that the applicant(s), in preparing the response, fully consider the items of evidence in their entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

Applicants arguments dated 2/9/06 have been considered but are unpersuasive of error. Applicants argue the deficiencies of each item of evidence when viewed in a vacuum rather than what the references taken collectively would have suggested to those skilled in the art. See *In re Rosselet*, 146 USPQ 183, and *In re Keller*, 208 USPQ 871.

Any inquiry concerning this communication should be directed to Salvatore Cangialosi at telephone number **(571) 272-6927**. The examiner can normally be reached 6:30 Am to 5:00 PM, Tuesday through Friday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell, can be reached at **(571) 272-6712**.

Any response to this action should be mailed to:

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Hand delivered responses should be brought to

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 3600 Customer Service Office whose telephone number is **(571) 272-3600**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


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